

### **REMARKS**

Favorable reconsideration of this application is respectfully requested, as amended. Claims 1 and 3-25 are currently pending.

Applicants kindly acknowledge the statement at page 2 of the Final Office Action that the following rejection has been withdrawn: Claims 1 and 11-18 under 35 U.S.C. § 103(a) as being unpatentable over Phybiosis Medicinal Clay Technical Specifications 1999 (Phybiosis Medicinal Clay), in view of U.S. Patent 6,378,138 to Ridgely *et al.* (Ridgely *et al.* '138), as evidenced by the Wikipedia definition of tourmaline..

At page 2 of the Final Office Action, Claim 22 has been objected to under 37 C.F.R. § 1.75 as being substantially duplicative of Claim 21. Responsive to this objection, Claim 22 has been amended to correct a typographical error by excluding tourmaline from the second group of naturally occurring elements. Accordingly, this objection has been overcome and should be withdrawn.

Claim 3 has been amended to make the recitation of the second group of elements consistent with that of Claim 1 from which Claim 3 depends.

New Claims 23-25 have been added. Support for new Claims 23-24 may be found in paragraph [0012] at page 4 of the present application. Support for new Claim 25 may be found in Claim 4 (as originally filed), as well as paragraph [0012] at page 5 of the present application.

**A. Response to Rejection of Claims 1 and 3-22 under 35 U.S.C. § 112, First Paragraph**

At pages 3-7 of the Final Office Action, Claims 1 and 3-22 have again been rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the enablement requirement. Specifically, the Final Office Action alleges that Claims 1 and 21, in reciting “a combination providing therapeutic benefit,” fails to provide information to one skilled in the art “to fully practice” the claimed invention “without undue experimentation.”

For reasons presented below, Applicants again respectfully traverse this rejection of Claims 1 and 3-22, as amended and as currently presented, under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. In support of this rejection, the Final Office Action again cites, but incorrectly and improperly applies, the following factors from *In re Wands*, 8 USPQ2d 1400 (Fed. Cir. 1988):

1. Scope and breadth of claims. The Final Office Actions again alleges that specification merely discloses, without more, that “a naturally occurring element combination can provide or improve the physical energy, well-being and support of individuals and provide relief from various types of pains and aches such as muscle stiffness, headache, menstrual pain, sprain, inflammation, arthritis, carpal tunnel, bruises, broken bones and sports injuries,” referring to paragraph [0008] at page 3 of the present application, and further alleges that “there is no evidence that the invention works as instantly claimed. But the Final Office Action again improperly puts the burden on Applicants to demonstrate that “the invention works as instantly claimed.” The Final Office Action still fails to point to any substantial evidence to support the alleged position that the claimed invention would not provide one or more of the therapeutic benefits described in paragraph [0008] at page 3 of the present application.<sup>1</sup> Accordingly, this allegation must still be based on the Examiner’s personal knowledge. Applicants, therefore, again respectfully request the Examiner to provide an affidavit/declaration under 37 CFR 1.104(d)(2) in support of this allegation which appears to be based on the Examiner’s personal knowledge, and not what is shown by any substantial evidence presented in the Final Office Action.<sup>2</sup>
2. Nature of the invention. The Final Office Action again merely alleges that the invention “is directed to an elemental combination for providing a therapeutic benefit.” But the Final Office Action again never says or explains why this allegation causes the claimed invention not to be enabled. Accordingly, this statement must still be based on something within the Examiner’s personal knowledge. Applicants, therefore, respectfully request

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<sup>1</sup> See, e.g., *In re Gartside*, 203 F.3d 1305, 1315-16, 53 USPQ2d 1769 (Fed. Cir. 2000) (factual findings must be set aside if unsupported by substantial evidence).

<sup>2</sup> Applicants note that in the unpublished case of *In re Sun*, 31 USPQ2d 1451, 1455 (Fed. Cir. 1993), the USPTO argued “the procedures established by 37 C.F.R. Section 1.107(b) (1993) [now 37 CFR § 1.104(d)(2)] *expressly entitle* an Applicant, on mere request, to an examiner affidavit that provides [citations that support the Examiner’s asserted level of skill in the art]” (emphasis added). Furthermore, in *In re Sun*, the Federal Circuit, held that “this procedure, so readily available, helps save the lack of citation in an office

the Examiner to provide an affidavit/declaration under 37 CFR 1.104(d)(2) to identify what this statement refers to as it appears to be based on the Examiner's personal knowledge.<sup>3</sup>

3. Relative level of skill possessed by one of ordinary skill in the art. The Final Office Action again alleges "that the relative level of skill possessed by one of ordinary skill in the art of medical research is relatively high, as a majority of lead investigators directing scientific research and development in this particular technological area possess an M.D. and/or a Ph.D. in a scientific discipline such as organic synthetic chemistry, medical chemistry, biochemistry, pharmacology, biology or the like." But the Final Office Action again never properly explains what the basis is for the alleged level of skill in the art. In fact, the Final Office Action still fails to cite any substantial evidence to support this alleged level of skill in art.<sup>4</sup> Accordingly, this alleged level of skill in the art must again be based on the Examiner's personal knowledge. Applicants, therefore, again respectfully request the Examiner to provide an affidavit/declaration under 37 CFR 1.104(d)(2) in support of this alleged level of skill in the art which appears to be based on the Examiner's personal knowledge, and not what shown by any substantial evidence presented in the Office Action.<sup>5</sup>
4. State of, or the amount of knowledge in, the prior art. The Final Office Action again alleges that "the therapeutic value of crystals is controversial in the art and there are not a sufficient number of reports available

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action from possible constitutional infirmity in denying reasonable notice and hence due process." See 31 USPQ2d at 1455.

<sup>3</sup> Applicants again note that in the unpublished case of *In re Sun*, 31 USPQ2d 1451, 1455 (Fed. Cir. 1993), the USPTO argued "the procedures established by 37 C.F.R. Section 1.107(b) (1993) [now 37 CFR § 1.104(d)(2)] *expressly entitle* an Applicant, on mere request, to an examiner affidavit that provides [citations that support the Examiner's asserted level of skill in the art]" (emphasis added). Furthermore, in *In re Sun*, the Federal Circuit, held that "this procedure, so readily available, helps save the lack of citation in an office action from possible constitutional infirmity in denying reasonable notice and hence due process." See 31 USPQ2d at 1455.

<sup>4</sup> See, e.g., *In re Gartside*, 203 F.3d 1305, 1315-16, 53 USPQ2d 1769 (Fed. Cir. 2000) (factual findings must be set aside if unsupported by substantial evidence).

<sup>5</sup> Applicants again note that in the unpublished case of *In re Sun*, 31 USPQ2d 1451, 1455 (Fed. Cir. 1993), the USPTO argued "the procedures established by 37 C.F.R. Section 1.107(b) (1993) [now 37 CFR § 1.104(d)(2)] *expressly entitle* an Applicant, on mere request, to an examiner affidavit that provides [citations that support the Examiner's asserted level of skill in the art]" (emphasis added). Furthermore, in *In re Sun*, the Federal Circuit, held that "this procedure, so readily available, helps save the lack of citation in an office

identifying the uses of crystal therapy. But the Final Office Action again provides only one citation in support of this allegation.<sup>6</sup> Once again, the Final Office Action nowhere properly shows or demonstrates that what is alleged by this one citation is “generally accepted” by those skilled in this art. Put differently, the Final Office Action has again failed to provide any substantial evidence to refute the therapeutic benefit described in the present application for the claimed invention.<sup>7</sup>

5. Level or degree of predictability, or lack thereof, in the art. The Final Office Action again alleges that “the safety and effectiveness of these techniques have not been thoroughly tested scientifically” and further alleges that “there is no evidence for this technique. But the Final Office Action again provides only one citation in support of this allegation.<sup>8</sup> Once again, the Final Office Action nowhere properly demonstrates that what is alleged by this one citation is “generally accepted” by those skilled in this art. Put differently, the Final Office Action has again failed to provide substantial evidence to refute the therapeutic benefit described in the present application for the claimed invention.<sup>9</sup> In fact, the art cited at page 2 of the present application (Background of Invention Section), as well as that relied on in the Final Office Action in rejecting the instant Claims shows and demonstrates to the contrary, that the therapeutic benefits alleged for the claimed invention are actually “generally accepted” by those skilled in this particular art.<sup>10</sup>

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action from possible constitutional infirmity in denying reasonable notice and hence due process.” See 31 USPQ2d at 1455.

<sup>6</sup> Harvard Medical School’s Consumer Health Information, Complementary & Alternative Medicine, Crystal Therapy, Electrocrystal Therapy (July 5, 2005), p. 2.

<sup>7</sup> See, e.g., *In re Gartside*, 203 F.3d 1305, 1315-16, 53 USPQ2d 1769 (Fed. Cir. 2000) (factual findings must be set aside if unsupported by substantial evidence).

<sup>8</sup> Harvard Medical School’s Consumer Health Information, Complementary & Alternative Medicine, Crystal Therapy, Electrocrystal Therapy (July 5, 2005), p. 3.

<sup>9</sup> See, e.g., *In re Gartside*, 203 F.3d 1305, 1315-16, 53 USPQ2d 1769, (Fed. Cir. 2000) (factual findings must be set aside if unsupported by substantial evidence).

<sup>10</sup> See column 1, lines 53-58 of U.S. Patent 6,014,973 (Kaufman), issued January 18, 2000 (method of healing comprising combination of five healing elements secured by flexible strand for wearing on body for “safely and reliably heal[ing] bodily ailments including, but not limited to, aches and pains, inflammation, sprains, arthritis, muscle stiffness, carpal tunnel, and injuries”); column 2, lines 19-24 of U.S. Patent 6,143,946 (Docter), issued November 7, 2000 (therapeutic mat including relatively elastic substrate, hydrogel connected to substrate and plurality of microcrystals dispersed throughout hydrogel for “treating wounds as a result of ulceration, bums, abrasions, angina, carpal tunnel, broken bones, fractures, wounds and incisions,

6. Amount of guidance or direction provided by the inventor. The Final Office Action again alleges that Applicants “[are] required to provide in the specification additional guidance and direction with respect to how to use the claimed subject matter in order for the application to be enabled with respect to the full scope of the claimed invention.” But what the Final Office Action again alleges or suggests is refuted by what is actually taught in the present application. The present application, in fact, provides sufficient “guidance” to practice the claimed invention, as in shown in, for example, paragraph [0013] at page 5 (describing what forms the claimed invention may take), paragraph [0014] at pages 5-6 (describing how the claimed invention may be worn or secured to the body, or the area or part of the body to be treated), paragraphs [0015]-[0016] at pages 6-7 (describing how the claimed invention may formulated for insertion, ingestion or application), paragraph [0017] at page 7 (describing how the claimed invention may be positioned for therapeutic treatment), and paragraph [0020] at pages 7-8 (describing how long the claimed invention should be positioned proximate to or in direct contact with the body to provide treatment benefits).
7. Presence or absence of working examples. The Final Office Action again alleges that the “specification fails to provide any scientific data and working embodiments with respect to a combination providing the therapeutic benefit.” But contrary to what is alleged or suggested in the Final Office Action, the above application does provide working examples, as illustrated in and described above with reference to paragraphs [0013]-[0017] and [0020] of the present application. Besides providing working examples, this allegation is irrelevant because there is no statutory requirement (*i.e.*, under 35 U.S.C. § 112, first paragraph) that there be any working examples in the specification. All that is required by 35 U.S.C. § 112, first paragraph, is that the specification teach one skilled in the art (not a layman, a patent examiner or a patent attorney/agent) how to practice the

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for example”); and column 1, lines 38-41 and column 2, line 31 through column 4, line 16 of U.S. Patent 6,378,138 (Ridgley et al), issued April 30, 2002 (stocking or hosiery that incorporates naturally occurring elements for “healing various bodily ailments”).

claimed invention. With regard to the question of working examples, neither the Patent Statutes, Rules of Practice nor case law require any working examples. In fact, the Final Office Action still fails to cite to any Patent Statute, Practice Rule and/or case law that requires working examples to be present in the application.

8. Quantity of experimentation required to make and use the claimed invention based upon the content of the supporting disclosure. The Final Office Action again alleges that Applicants have “not disclosed any working examples nor suggested the amount of material required in what ratios, and for what duration they must be applied/administered to the patient in order to achieve a therapeutic benefit,” including “how much of the composition is required to provide such a benefit if ingested,” “how does one of ordinary skill in the art know if an individual is in need of vibrational therapy, “how does one of ordinary skill in the art know which combination to place where next to the individual to provide a therapeutic benefit?” The Final Office Action then alleges again that, as a result, “one of ordinary skill in the art would be required to conduct labor intensive trial and error experimentation with each and every combination in a myriad number of ratios of components for an unknown period of time, nor to mention the preferred route of administration such as oral, topical, or rectal, on patients suffering from, for example, pain in order to ascertain if the combination had the desired therapeutic effect,” and further alleges that “one of ordinary skill in the art would have to conduct an undue amount of experimentation to reasonably and accurately determine whether the combination would provide a therapeutic benefit.” But as noted above, and contrary to what the Final Office Action alleges or suggests, and as shown in paragraphs [0013]-[0017] and [0020] of the present application, Applicants have provided sufficient guidance for one skilled in this art to practice the claimed invention without “undue experimentation.”

In conclusion, the Final Office Action once again alleges that “it is readily apparent from the from the aforementioned disclosure, in conjunction with a corresponding lack of

scientific data and working embodiments regarding the therapeutic benefit of the combination, that one of ordinary skill in the art would therefore be required to conduct an undue amount of experimentation to reasonably and accurately extrapolate whether said combination would be therapeutically beneficial,” citing to *Genentech*, 108 F.3d 1366. But, for at least the reasons presented above, it is, in fact, the Final Office Action, which has still failed to provide any substantial evidence or any appropriate basis to support the rejection of Claims 1 and 3-22 for lack of enablement.

In response to Applicants’ assertion that the “Examiner has improperly put the burden on [Applicants] to demonstrate that the invention works as instantly claimed and that the allegation must be based on the Examiner’s personal knowledge,” the Examiner says that he “cannot agree” and cites the following passage from MPEP § 2164.02: “In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention.”<sup>11</sup> The Office Action further quotes the following from *In re Marzocchi*:<sup>12</sup> “A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of [35 U.S.C. § 112, first paragraph], unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. Assuming sufficient reason for such doubt exists, a rejection for failure to teach how to make and/or use will be proper on that basis.” The Examiner then alleges that he “has correctly doubted the objective truth by providing two citations which clearly state that this is a controversial issue, that there is insufficient reports available and that there is no evidence for this technique.”

But from reviewing the Final Office Action, there appears to be only one citation<sup>13</sup> provided in support of this lack of enablement rejection, not two as alleged. As Applicants have also properly pointed out above, this one citation from the Final Office Action fails show or demonstrate that what is alleged by this one citation is “generally accepted” by

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<sup>11</sup> Citing *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of the protection provided by a claim is not adequately enabled by the disclosure)

<sup>12</sup> 439 F.2d 220, 224 169 USPQ 367, 370 (CCPA 1971)

<sup>13</sup> Harvard Medical School’s Consumer Health Information, *Complementary & Alternative Medicine*, Crystal Therapy, Electrocrystal Therapy (July 5, 2005), p. 3.

those skilled in this art, and is therefore insufficient to provide a “reasonable basis” to question the enablement of Applicants claimed invention taught in the present application. In fact, the Final Office Action’s allegation ignores a key portion of the quote from *In re Marzocchi*, namely that the Examiner’s assertions be backed up “with acceptable evidence or reasoning which is inconsistent with the contested statement.” (Emphasis added.) Instead, the Final Office Action either provides conclusory statements unsupported by any verifiable evidence, or relies on completely insufficient and insubstantial evidence (*i.e.*, one citation) to support this lack of enablement rejection.

The Final Office Action also erroneously and improperly discounts Applicants’ rebuttal evidence based on at least three granted U.S. patents<sup>14</sup> that the therapeutic benefits alleged for the claimed invention are actually “generally accepted” by those skilled in this particular art. Instead, the Final Office Action alleges that “examination is a case-by-case process.” But why “examination is a case-by-case process” is relevant to the current lack of enablement rejection of the instant Claims is never adequately explained in the Final Office Action. In fact, the Final Office Action never explains with adequate “reasoning” why Applicants’ rebuttal evidence based on at least three granted U.S. patents<sup>15</sup> that show the therapeutic benefits alleged for the claimed invention are “generally accepted” by those skilled in this particular art fails to overcome the sole citation presented by the Final Office Action to the contrary.

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<sup>14</sup> See column 1, lines 53-58 of U.S. Patent 6,014,973 (Kaufman), issued January 18, 2000 (method of healing comprising combination of five healing elements secured by flexible strand for wearing on body for “safely and reliably heal[ing] bodily ailments including, but not limited to, aches and pains, inflammation, sprains, arthritis, muscle stiffness, carpal tunnel, and injuries”); column 2, lines 19-24 of U.S. Patent 6,143,946 (Dokter), issued November 7, 2000 (therapeutic mat including relatively elastic substrate, hydrogel connected to substrate and plurality of microcrystals dispersed throughout hydrogel for “treating wounds as a result of ulceration, burns, abrasions, angina, carpal tunnel, broken bones, fractures, wounds and incisions, for example”); and column 1, lines 38-41 and column 2, line 31 through column 4, line 16 of U.S. Patent 6,378,138 (Ridgley et al), issued April 30, 2002 (stocking or hosiery that incorporates naturally occurring elements for “healing various bodily ailments”).

<sup>15</sup> See column 1, lines 53-58 of U.S. Patent 6,014,973 (Kaufman), issued January 18, 2000 (method of healing comprising combination of five healing elements secured by flexible strand for wearing on body for “safely and reliably heal[ing] bodily ailments including, but not limited to, aches and pains, inflammation, sprains, arthritis, muscle stiffness, carpal tunnel, and injuries”); column 2, lines 19-24 of U.S. Patent 6,143,946 (Dokter), issued November 7, 2000 (therapeutic mat including relatively elastic substrate, hydrogel connected to substrate and plurality of microcrystals dispersed throughout hydrogel for “treating wounds as a result of ulceration, burns, abrasions, angina, carpal tunnel, broken bones, fractures, wounds and incisions, for example”); and column 1, lines 38-41 and column 2, line 31 through column 4, line 16 of U.S. Patent 6,378,138 (Ridgley et al), issued April 30, 2002 (stocking or hosiery that incorporates naturally occurring elements for “healing various bodily ailments”).



Accordingly, for at least the above reasons, Applicants again respectfully request that this rejection of Claims 1 and 3-22 under 35 U.S.C. § 112, first paragraph, for lack of enablement be withdrawn.

**B. Response to Rejection of Claims 1, 3, 7-10, 16 and 18-22 under 35 U.S.C. § 102(b) as Anticipated by Ridgely *et al.* '138**

At pages 8-9 of the Final Office Action, Claims 1, 3, 7-10, 16 and 18-22 have again been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 6,378,138 to Ridgely *et al.* (Ridgely *et al.* '138), as evidenced by the Wikipedia definition of tourmaline.

Briefly, Ridgely *et al.* '138 discloses stocking or hosiery that incorporates naturally occurring elements for healing various bodily ailments. These naturally occurring elements may include Alexandrite, Amazonite, amber, Amethyst, Aquamarine, Aventurine, Azurite, Bloodstone, Calcite, Carelian, Celestite, Chrysoprase, Citrine, Diamond, Diopase, Emerald, Fluorite, Garnet, Gold, Hematite, Herkimer Diamond, Jade, Jasper, Kunzite Pink, Lapis Lazuli, Lepidolite, Malachite, Moonstone, Obsidian, Onyx, Opal, Peridot, Pyrite, Quartz Crystal, Rhodochrosite, Rhodonite, Rose Quartz, Ruby, Rutilated Quartz, Smoky Quartz, Sugilite, Sodalite, Sapphire, Silver, tiger Eye, Topaz, Tourmaline, Turquoise, and Zircon. See column 2, lines 14-28.

Applicants again respectfully traverse this rejection of Claims 1, 3, 7-10, 16 and 18-22, as amended and as currently presented, as anticipated by Ridgely, *et al.* '318, even in view of the Wikipedia definition of tourmaline for the following reasons. Claim 1 recites a combination comprising: (1) at least one naturally occurring element selected from a first group consisting of charoite, rubellite, rubellite with quartz, and rhyolite; and (2) at least one naturally occurring element selected from a second group consisting of alexandrite, amazonite, amber, amethyst, aquamarine, aventurine, azurite, bloodstone, calcite, carelian, celestite, chrysoprase, citrine, copper, diamond, diopase, emerald, fluorite, garnet, gold, hematite, Herkimer diamond, jade, jasper, kunzite pink, lapis lazuli, lepidolite, malachite, manganese, moonstone, moss agate, obsidian, onyx, opal, peridot, pyrite, quartz crystal, rhodochrosite, rhodonite, rose quartz, ruby, rutilated quartz, smoky quartz, sugilite, sodalite, sapphire, silver, tiger eye, topaz, tourmaline, turquoise and zircon. (Emphasis added.) By contrast, Ridgely *et al.* '138 does not teach or suggest at least one naturally

occurring element from the first group of Claim 1, with at least one naturally occurring element from the second group of Claim 1. In fact, Ridgely *et al.* '138 does not teach any of the elements from the first group of Claims 1, including rubellite.

The Final Office Action again alleges that “red and pink tourmaline is known as rubellite,” citing the Wikipedia definition of “tourmaline” at page 2 under “other names for tourmaline.” But, as was pointed out in Applicants’ prior response of January 17, 2007, other art, including that previously cited by the Examiner, suggests that “tourmaline” and “rubellite” are entirely different gem stones.<sup>16</sup> In other words, the alleged art again does not conclusively show, as required by 35 U.S.C. § 102(b), that “tourmaline” and “rubellite” are the same or equivalent terms based on what is fairly disclosed by Ridgely *et al.* '138.

In addition, and contrary to what is alleged or suggested, the Final Office Action’s reliance on the Wikipedia definition for the alleged equivalency of “tourmaline” and “rubellite” is completely misplaced and improper. The PTO has made clear that the Wikipedia is not now an approved source of art and should not be relied on in rejecting claims.<sup>17</sup> In short, the Final Office Action cannot properly rely on the alleged Wikipedia definition for the alleged equivalency of “tourmaline” and “rubellite,” and therefore the Final Office Action has provided no verifiable factual basis for asserting this alleged equivalency of “tourmaline” and “rubellite.”

In addition, and as was pointed out in Applicants’ prior response of January 17, 2007, the Final Office Action has still misapplied the requirements MPEP § 2131.01 as to when it is proper to use multiple references in rejecting claims under 35 U.S.C. § 102(b) where the secondary reference (*i.e.*, the Wikipedia definition of “red” and “pink” tourmaline which, as noted above, is not properly citable) is being used to show an allegedly inherent characteristic of the primary reference (*i.e.*, “tourmaline” taught in Ridgely *et al.* '138). See *Continental Can Co. USA v. Monsanto Co.*,<sup>18</sup> which is cited to in MPEP § 2131.01: “To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to

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<sup>16</sup> See column 4, line 51, of U.S. Patent 6,145,341 (Leong). See also column 2, lines 33-35 of U.S. Patent 4,857,306 (Roller).

<sup>17</sup> See “Kicking Wiki Out of the Patent Office in September 4, 2006 issue of Business Week at [http://www.businessweek.com/magazine/content/06\\_36/c3999012.htm](http://www.businessweek.com/magazine/content/06_36/c3999012.htm) where Commissioner for Patents, John Doll is quoted as saying “we’ve taken Wikipedia off our list of accepted sources of information” and is further quoted as indicating that the PTO has used Wikipedia entries as background and not as a basis for accepting or rejecting an application.

extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” (Emphasis added.) As was pointed out Applicants’ prior response of January 17, 2007, and contrary to the holding in *Continental Can*, the Final Office Action has failed to establish that it is “clear that the missing descriptive matter” (*i.e.*, “red” and “pink” tourmaline is the same or equivalent to rubellite) “is necessarily present in the thing described in the reference” (*i.e.*, tourmaline taught in Ridgely *et al.* ‘138), and “that it would be so recognized by persons of ordinary skill.”

As was pointed out in Applicants’ prior response of January 17, 2007, Claim 21, as amended, is distinguishable over Ridgely *et al.* ‘138 for a different reason. As amended, Claim 21 excludes tourmaline from the second group of naturally occurring elements. By contrast, Ridgely *et al.* ‘138 does not disclose compositions comprising combinations of the first group of naturally occurring elements with the amended second group of naturally occurring elements according to amended Claim 21. In addition, Ridgely *et al.* ‘138 does not teach or suggest the first group combination of pearl and rhyolite according to new Claim 23, the combination of the first group of Claim 23 with the second group of elements according to new Claim 24, or the amounts specified for the combination of Claim 24 according to new Claim 25.

As was further pointed out in Applicants’ prior response of January 17, 2007, Claim 22 is also distinguishable over Ridgely *et al.* ‘138 for a different reason. As presented, Claim 22 recites that at least one naturally occurring element selected from a first group consisting of charoite, rubellite, rubellite with quartz, and rhyolite, in combination with at least one naturally occurring element selected from a second group consisting of alexandrite, amazonite, amber, amethyst, aquamarine, aventurine, azurite, bloodstone, calcite, carelian, celestite, chrysoprase, citrine, copper, diamond, diopase, emerald, fluorite, garnet, gold, hematite, Herkimer diamond, jade, jasper, kunzite pink, lapis lazuli, lepidolite, malachite, manganese, moonstone, moss agate, obsidian, onyx, opal, peridot, pyrite, quartz crystal, rhodochrosite, rhodonite, rose quartz, ruby, rutilated quartz, smoky quartz, sugilite, sodalite, sapphire, silver, tiger eye, topaz, turquoise and zircon, *i.e.*, tourmaline is not included. By contrast, Ridgely *et al.* ‘138 does not disclose any of the

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<sup>18</sup> 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).

second group of naturally occurring elements in combination with the first group of naturally occurring elements according to new Claim 22.

For at least the foregoing reasons, Claims 1, 3, 7-10, 16 and 18-22, as amended or as currently presented, as well as new Claims 23-25, are novel and unobvious over Ridgely *et al.* '138.

**C. Response to Rejection of Claims 1, 7, 16 and 18-22 under 35 U.S.C. § 102(b) as Anticipated by Untracht**

At pages 9-10 of the Final Office Action, Claims 1, 3, 7-10, 16 and 18-22 have again been rejected under 35 U.S.C. § 102(b) as being anticipated by Untracht, O., Jewelry Concepts and Technology (Untracht), as evidenced by the Wikipedia definition of tourmaline.

Briefly, page 510 of Untracht discloses in photograph 11-55 a symmetrical necklace in sterling silver, with 19 tourmalines. Page 601 of Untracht discloses in photograph 11-55 a gold ring with a flat-topped barrel-shaped tourmaline set in divided bezel. .

Applicants again respectfully traverse this rejection of Claims 1, 7, 16 and 18-22, as amended or as currently presented, as anticipated by Untracht, even in view of the Wikipedia definition of tourmaline for the following reasons. Claim 1 recites a combination comprising: (1) at least one naturally occurring element selected from a first group consisting of charoite, rubellite, rubellite with quartz, and rhyolite; and (2) at least one naturally occurring element selected from a second group consisting of alexandrite, amazonite, amber, amethyst, aquamarine, aventurine, azurite, bloodstone, calcite, carelian, celestite, chrysoprase, citrine, copper, diamond, diopase, emerald, fluorite, garnet, gold, hematite, Herkimer diamond, jade, jasper, kunzite pink, lapis lazuli, lepidolite, malachite, manganese, moonstone, moss agate, obsidian, onyx, opal, peridot, pyrite, quartz crystal, rhodochrosite, rhodonite, rose quartz, ruby, rutilated quartz, smoky quartz, sugilite, sodalite, sapphire, silver, tiger eye, topaz, tourmaline, turquoise and zircon. (Emphasis added.) By contrast, Untracht does not teach or suggest at least one naturally occurring element from the first group of Claim 1, with at least one naturally occurring element from the second group of Claim 1. In fact, Untracht does not teach any of the elements from the first group of Claim 1, including rubellite.

The Final Office Action again alleges that “red and pink tourmaline is known as rubellite,” citing the Wikipedia definition of “tourmaline” at page 2 under “other names for tourmaline.” But, as was pointed out in Applicants’ prior response of January 17, 2007, other art, including that previously cited by the Examiner, suggests that “tourmaline” and “rubellite” are entirely different gem stones.<sup>19</sup> In other words, the alleged art again does not conclusively show, as required by 35 U.S.C. § 102(b), that “tourmaline” and “rubellite” are the same or equivalent terms as tourmaline disclosed by Untracht.

In addition, like the anticipation rejection of Claims 1, 3, 7-10, 16 and 18-22 based on Ridgely *et al.* ‘138, the Final Office Action’s reliance on the Wikipedia definition for the alleged equivalency of “tourmaline” and “rubellite” is completely misplaced and improper. The PTO has made clear that the Wikipedia is not now an approved source of art and should not be relied on in rejecting claims.<sup>20</sup> In short, the Final Office Action cannot properly rely on the alleged Wikipedia definition for the alleged equivalency of “tourmaline” and “rubellite,” and therefore the Final Office Action has provided no verifiable factual basis for asserting this alleged equivalency of “tourmaline” and “rubellite.”

In addition, and as was pointed out in Applicants’ prior response of January 17, 2007, the Final Office Action has still misapplied the requirements MPEP § 2131.01 as to when it is proper to use multiple references in rejecting claims under 35 U.S.C. § 102(b) where the secondary reference (*i.e.*, the Wikipedia definition of “red” and “pink” tourmaline which, as noted above, is not properly citable) is being used to show an allegedly inherent characteristic of the primary reference (*i.e.*, “tourmaline” taught in Ridgely *et al.* ‘138). See *Continental Can Co. USA v. Monsanto Co.*,<sup>21</sup> which is cited to in MPEP § 2131.01: “To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so

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<sup>19</sup> See column 4, line 51, of U.S. Patent 6,145,341 (Leong). See also column 2, lines 33-35 of U.S. Patent 4,857,306 (Roller).

<sup>20</sup> See “Kicking Wiki Out of the Patent Office in September 4, 2006 issue of Business Week at [http://www.businessweek.com/magazine/content/06\\_36/c3999012.htm](http://www.businessweek.com/magazine/content/06_36/c3999012.htm) where Commissioner for Patents, John Doll is quoted as saying “we’ve taken Wikipedia off our list of accepted sources of information” and is further quoted as indicating that the PTO has used Wikipedia entries as background and not as a basis for accepting or rejecting an application.

recognized by persons of ordinary skill.” (Emphasis added.) As was pointed out Applicants’ prior response of January 17, 2007, and contrary to the holding in *Continental Can*, the Final Office Action has still failed to establish that it is “clear that the missing descriptive matter” (*i.e.*, “red” and “pink” tourmaline is the same or equivalent to rubellite) “is necessarily present in the thing described in the reference” (*i.e.*, tourmaline taught in Untracht), and “that it would be so recognized by persons of ordinary skill.”

As was pointed out in Applicants’ prior response of January 17, 2007, Claim 21, as amended, is distinguishable over Untracht for a different reason. As amended, Claim 21 excludes tourmaline from the second group of naturally occurring elements. Untracht does not disclose compositions comprising combinations of the first group of naturally occurring elements with the amended second group of naturally occurring elements according to amended Claim 21. In addition, Untracht does not teach or suggest the first group combination of pearl and rhyolite according to new Claim 23, the combination of the first group of Claim 23 with the second group elements according to new Claim 24, or the amounts specified for the combination of Claim 24 according to new Claim 25.

As was further pointed out in Applicants’ prior response of January 17, 2007, Claim 22 is also distinguishable over Untracht for a different reason. As presented, Claim 22 recites at least one naturally occurring element selected from a first group consisting of charoite, rubellite, rubellite with quartz, and rhyolite, in combination with at least one naturally occurring element selected from a second group consisting of alexandrite, amazonite, amber, amethyst, aquamarine, aventurine, azurite, bloodstone, calcite, carelian, celestite, chrysoprase, citrine, copper, diamond, diopase, emerald, fluorite, garnet, gold, hematite, Herkimer diamond, jade, jasper, kunzite pink, lapis lazuli, lepidolite, malachite, manganese, moonstone, moss agate, obsidian, onyx, opal, peridot, pyrite, quartz crystal, rhodochrosite, rhodonite, rose quartz, ruby, rutilated quartz, smoky quartz, sugilite, sodalite, sapphire, silver, tiger eye, topaz, tourmaline, turquoise and zircon, *i.e.*, tourmaline is not included. By contrast, Untracht does not disclose any of the second group of naturally occurring elements in combination with the first group of naturally occurring elements according to new Claim 22..

For at least the foregoing reasons, Claims 1, 7, 16 and 18-22, as amended or as currently presented, as well as new Claims 23-25, are novel and unobvious over Untracht.

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<sup>21</sup> 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).

**D. Response to Rejection of Claims 1, 3-11 and 19-22 under 35 U.S.C. § 103(a) as Unpatentable over Untracht**

At pages 9-11 of the Final Office Action, Claims 1, 3-11 and 19-21 have again been rejected under 35 U.S.C. § 103(a) as being unpatentable over Untracht.

The Final Office Action again concedes that Untracht does not teach: (1) the specific amount of the naturally occurring elements according to Claims 4-6; or (2) the devices (*e.g.*, strap, clothing, furniture, *etc.*) according to Claims 7-10. Instead, the Office Action again alleges that it would have been obvious “to make naturally occurring element combinations in the amounts of from 1 to 10 parts and the narrower range of about 1 to about 2 parts and make devices associated with the combination which are a strap, clothing or furniture including the combination and produce the instant invention.” The alleged “motivation” provided by the Office Action is that “because in the art of making jewelry one of ordinary skill in the art is inclined to mix and match various naturally occurring elements to create various combinations as shown in Untracht,” that “one of ordinary skill in the art can mix and match any naturally occurring elements in any ratio to produce such combinations,” and that “adornment of straps, clothing and furniture is a reasonable extension of the artisan to decorate items for market.”

Applicants again respectfully traverse this rejection of Claims 1, 3-11 and 19-22, as amended and as currently presented, over Untracht for reasons previously presented as to why Claims 1, 7, 10 and 19-22 are novel and unobvious over Untracht, and for the following additional reasons. With regard to Claims 4-6 and 7-10, this rejection is still *prima facie* improper because the Final Office Action has failed to properly allege a *prima facie* case of obviousness. As set forth in MPEP § 706.02(j): “To establish a *prima facie* case of obviousness, [the following] criteria must be met. First, *there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings . . . .* Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The *teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Appellant’s disclosure.*”<sup>22</sup>

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<sup>22</sup> *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See also MPEP § 2143- §2143.03 for decisions pertinent to each of these criteria (emphasis added).”

As pointed out in Applicants' prior response of January 17, 2007, and as again conceded by the Final Office Action, Untracht does not teach or suggest all of the features of Claims 4-6 or Claims 7-10. In other words, the rejection of these Claims fails to satisfy at least one of the criteria (prior art reference, or references when combined, must teach or suggest all the claim limitations) set forth in MPEP § 706.02(j) for a *prima facie* case of obviousness. Instead, these allegations regarding Claims 4-6 and Claims 7-10 still appear to be based on the Examiner's personal knowledge.

In response, the Final Office Action alleges that the rejection of Claims 4-10 is not based on the Examiner's personal knowledge, but instead alleges that figure 11-55 of Untracht shows multiple tourmaline stones in a silver necklace, and that figure 13-47 of Untracht shows a tourmaline in a gold ring." Based on these alleged teachings, the Final Office Action alleges that "Untracht establishes using different amounts of components in the compositions (which are designed to decorate the body and hand around the neck or finger) and it is merely judicious selection and routine optimization to create the piece by one of ordinary skill in the art." But this alleged basis for using different amounts ("by judicious selection and routine optimization") of tourmaline or any other gem stone is simply unsupported speculation because the reference relied on (Untracht), when fairly read, says nothing about how to vary the amounts of these gemstones, and especially not according to Claims 4-6. In fact, the Final Office Action's allegation that the amounts defined in Claims 4-6 involve "routine optimization" is inconsistent and at odds with the Final Office Action's allegation that these same Claims lack enablement under 35 U.S.C. § 112, first paragraph. And the Final Office Action still fails to identify where the admittedly absent claim features from Claims 7-10 (e.g., adornment of straps, clothing and furniture) are shown in the art, in violation of 37 CFR 1.104(c)(2).

The rejection of Claims 4-10 is additionally *prima facie* improper because the Final Office Action has failed to properly allege any proper teaching, suggestion or motivation from the reference relied on or any other verifiable evidence to support the alleged "judicious selection and routine optimization" of Untracht by one skilled in the art. To properly modify the teachings of Untracht, the Office Action must provide a suggestion, teaching or motivation in the cited references.<sup>23</sup> The suggestion, teaching or motivation

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<sup>23</sup> See, e.g., *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined only if there is some suggestion or incentive to do so").



may be implicit or explicit.<sup>24</sup> But “[r]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion obviousness.<sup>25</sup> In fact, the Final Office Action allegations regarding the “motivation” to alter or modify the teachings of Untracht as suggested is nothing more than speculation which is unrelated to and unsupported by any verifiable factual evidence.

In summary, the Examiner allegations regarding the obviousness of Claims 4-10 over Untracht again appear to be based on his personal knowledge. Accordingly, if the Examiner wishes to persist in these allegations regarding Claims 4-10, Applicants again respectfully request that he provide an affidavit/declaration under 37 CFR 1.104(d)(2) because these allegations appear to be based on the Examiner’s personal knowledge, and not what is fairly taught by the art relied on in the Final Office Action.<sup>26</sup>

For at least the foregoing reasons, Claims 1, 3-11 and 19-22, as amended or as currently presented, are unobvious over Untracht.

#### **E. Conclusion**

Claims 1 and 3-25, as amended or as currently presented, comply with the enablement requirement under 35 U.S.C. § 112, first paragraph. Claims 1 and 3-25, as amended or as currently presented, are also novel and unobvious over the art relied on in the Office Action. Accordingly, Claims 1 and 3-25, as amended or as currently presented, should now be in condition for allowance.

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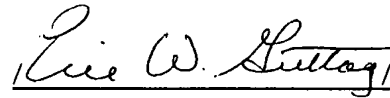
<sup>24</sup> See e.g., *In re Kahn*, 78 U.S.P.Q.2d 1329, 1336 (Fed. Cir. 2006) (“A suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated by the references....

<sup>25</sup> See e.g., *In re Kahn*, 78 U.S.P.Q.2d at 1336. See also admonition by the Deputy Commissioner for Patent Operations for the USPTO in a May 3, 2007 memorandum in response to Supreme Court’s recent decision in *KSR International Co. v. Teleflex, Inc.*, 550 U.S. \_\_\_\_ (2007) that “in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.”

<sup>26</sup> Applicants again note that in the unpublished case of *In re Sun*, 31 USPQ2d 1451, 1455 (Fed. Cir. 1993), the USPTO argued “the procedures established by 37 C.F.R. Section 1.107(b) (1993) [now 37 CFR § 1.104(d)(2)] *expressly entitle* an Applicant, on mere request, to an examiner affidavit that provides [citations that support the Examiner’s asserted level of skill in the art]” (emphasis added). Furthermore, in *In re Sun*, the Federal Circuit, held that “this procedure, so readily available, helps save the lack of citation in an office action from possible constitutional infirmity in denying reasonable notice and hence due process.” See 31 USPQ2d at 1455.

If the Examiner believes, after entering this preliminary amendment into the record, that the present application is not in condition for examination, the Examiner is invited to contact Applicants' representative, Eric W. Guttag, at 513-856-7272.

Respectfully submitted,

A handwritten signature in cursive script, reading "Eric W. Guttag", written over a horizontal line.

Eric W. Guttag  
Reg. No. 28,853  
Customer No. 22,506

**JAGTIANI + GUTTAG**  
Democracy Square Business Center  
10363-A Democracy Lane  
Fairfax, Virginia 22030  
703-591-2664

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